

## **REMARKS**

### **Claim Amendments**

Applicants presently cancel system claims 15-28 and computer program product claims 29-42, leaving only method claims in the present application. In amending the claims in the present application, Applicants do not concede that the claims as originally filed were not in a condition for allowance nor do these cancellations represent a disclaimer of the recited subject matter. Rather, Applicants will pursue these cancelled system and product claims in one or more continuation applications. Applicants believe themselves entitled to pursue these claims in additional applications because the system and product claims are directed to an invention in a different statutory category than are the method claims that remain in this application. Applicants believe they are entitled to have claims directed to inventions in separate statutory categories issued in separate patents.

### **Objections to the Drawings**

The Office Action objects to the drawings of the present application at page 2, stating:

1. The drawings are objected to because:
  - a. Item 406 of figure 5 has a typographical error in the word “identify”.
  - b. Item 404 of figure 5 is not labeled.

In response to the objection regarding item 406 in figure 5, Applicants presently amend item 406 in figure 5 to change the reference character labeled “Identify Currently Designated Item” from “406” to “407”. In response to the objection regarding item 404 in figure 5, Applicants presently amend figure 5 to remove previously unlabelled reference character 404 and insert reference character 410 which is labeled “Multiplicity of Items.” Applicants submit that the present amendments do not introduce any new matter into this present application. Applicants respectfully request that the objections to the drawings be withdrawn.

### **Objections to the Claims**

The Office Action objects to claims 12, 26, and 40 at page 3, stating:

Claims 12, 26, and 40 are improperly worded “further wherein”.  
Appropriate correction is required.

As discussed above, claims 26 and 40 are presently cancelled in this Response. Claim 12 is presently amended to remove the term “further” from the claim language. Applicants submit that the present amendments do not introduce any new matter into this present application. Applicants respectfully request that the objections to the claims be withdrawn.

### **Claim Rejections – 35 U.S.C. § 112, Second Paragraph**

The Office Action rejects claim 10 of the present application under 35 U.S.C. § 112, second paragraph, for failing to point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states at page 3 that:

Claim 10 recites the limitation “visually designating an item comprises changing a video display of the item” in claim 4. There is insufficient antecedent basis for this limitation in the claim.

It would appear that claim 10 should depend on claim 7.

In response to the rejection of claim 10 under 35 U.S.C. § 112, Applicants have amended claim 10 in the present application to depend from claim 7 rather than 4. Applicants respectfully submit that amended claim 10 satisfies all requirements of 35 U.S.C. § 112 and is therefore patentable. Applicants request reconsideration of claim 10 in the present application.

### **Claim Rejections – 35 U.S.C. § 101**

The Office Action rejects claims 29-42 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As discussed above, Applicants presently cancel claims 29-42 in

this Response. In amending the claims of the present application, Applicants in no way concede that claims 29-42 do not recite statutory subject matter within the meaning of 35 U.S.C. §101. Because claims 29-42 are presently cancelled in this Response, however, Applicants respectfully request that the rejections of now-cancelled claims 29-42 under 35 U.S.C. § 101 be withdrawn.

### **Claims Rejections – 35 U.S.C. § 102**

Applicants' original claims 1-4, 6-8, 10, 15-18, 20-22, 24, 29-32, 34-36, and 38 stand rejected under 35 U.S.C. § 102 as being anticipated by Broadwin, *et al.* (U.S. Patent No. 5,929,850) (hereafter 'Broadwin'). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants' original claims 15-18, 20-22, 24, 29-32, 34-36, and 38 are presently cancelled. To anticipate remaining claims 1-4, 6-8, and 10 under 35 U.S.C. § 102, Broadwin must disclose and enable each and every element and limitation recited in the claims of the present application

Independent claim 1 as presently amended recites:

1. A method for delivering interactive non-intrusive advertising content, the method comprising:

receiving a selection signal indicating that a user has selected an item displayed on a television screen, the item included in the television program being displayed, wherein the item has associated non-intrusive interactive advertising content;

responsive to receiving the selection signal, identifying the selected item; and

displaying the associated non-intrusive interactive advertising content.

As explained in more detail below, Broadwin generally discloses an interactive television system with web-like navigational capabilities. Broadwin does not disclose, however, any of the elements of claim 1 in the present application. Broadwin does not disclose selecting an item that is included in a television program being displayed, and as such, Broadwin cannot possibly disclose the claims of the present application. Broadwin therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102. Claim 1 is therefore patentable and should be allowed.

**Broadwin Does Not Disclose Selecting An Item  
Included In The Television Program Being Displayed**

The Office Action takes the position that Broadwin at column 3, lines 44-65, column 5, lines 64-66, column 7, lines 52-63, and figures 6, 8, 13, 14, 17, and 18, discloses the first element of claim 1: receiving a selection signal indicating that a user has selected an item displayed on a television screen, the item included in the television program being displayed, wherein the item has associated non-intrusive interactive advertising content. Applicants respectfully note in response, however, that what Broadwin at column 3, lines 44-65, in fact discloses is:

The present invention thus comprises an interactive television system with web-like navigational capabilities. As one example, the present invention provides an improved system and method for displaying advertising content in an interactive television system. A user viewing the television can select an option which displays the advertising content of a respective advertiser or vendor. When the user selects this option, the television hyperlinks to one or more high quality compressed video stills which are being broadcast on the dedicated one or more still image channels which display the advertiser's goods or services. In the preferred embodiment, the video stills are presented in a format similar to Internet pages. The still images may include thumbprint images which link to other stills. The user may select respective thumbprints to view a full-screen image of the thumbprint image. Still images may also include a selection which enables the user to order a product or to provide an indication that the user desires to receive more information. The present invention thus enables

advertisers to more intuitively provide advertising content in an interactive television medium.

And what Broadwin at column 5, lines 64-66 in fact discloses is:

The television 150 includes a remote control 152 which facilitates user interaction with the television 150 and/or interactive decoder 140.

And what Broadwin at column 7, lines 52-63 in fact discloses is:

The interactive decoder 140 also includes an input for receiving user input. This user input is provided to an input of the CPU 314. This user input may be provided from various devices, preferably from remote control 152 or from buttons on the TV 150 or the interactive decoder 140. The user input provided to the CPU 314 enables a user to interact with the interactive application. For example, the user or viewer may choose a selection or button displayed on the screen to view a linked still image according to the present invention. The user or viewer may also choose a selection or button to order a product or order information, provide answers to a television game show, etc.

That is, Broadwin at the cited reference points discloses an interactive television system with web-like navigational capabilities. Broadwin's interactive television system with web-like navigational capabilities does not disclose receiving a selection signal indicating that a user has selected an item displayed on a television screen, wherein the item is included in the television program being displayed, and wherein the item has associated non-intrusive interactive advertising content as claimed in the present application because Broadwin does not disclose selecting an item that is included in a television program being displayed. According to the claims of the present invention, a user selects an item that is included in a television program being displayed on a television. Selecting an item that is included in a television program being displayed may include, for example, selecting the sweater worn by a particular character in a television program. *See*, Applicants' original specification at page 3, lines 12-18. In contrast to the claims of the present application, Broadwin describes an interactive television system that merely displays "selection options which reference or link to MPEG stills." Broadwin at column 2, lines 47-50. That is, Broadwin only discloses that a user is allowed to make a selection

from ‘selection options’ on a screen. Broadwin at the reference points cited in the Office Action and all other reference points, however, does not disclose that a ‘selection option’ is an item that is included in a television program. In fact, Broadwin at column 17, lines 34-47 discloses that a ‘selection option’ may take the form of thumbprint images – not items that are included in a television program. Because Broadwin does not disclose each and every element and limitation of Applicants’ claims, Broadwin does not anticipate Applicants’ claims, and the rejections under 35 U.S.C. § 102 should be withdrawn.

### **Broadwin Does Not Enable Each and Every Element Of The Claim Of The Present Application**

Not only must Broadwin disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants’ claims, but also Broadwin must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the Appellant’s chemical compound. The court in *Hoeksema* stated: “We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Broadwin places Applicants’ claims in the possession of a person of ordinary skill in the art, Broadwin is legally insufficient to anticipate Applicants’ claims under 35 U.S.C. § 102. As explained above, Broadwin does not disclose each and every element and limitation of independent claim 1 of the present application. Because Broadwin does not disclose each and every element and limitation of the independent claim, Broadwin cannot possibly place the elements and limitations of the independent claim in the possession of a person of ordinary skill in the art. Broadwin cannot, therefore, anticipate claim 1 of the present application.

### **Relations Among Claims**

Claims 2-4, 6-8, and 10 depend from independent claim 1. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Broadwin does not disclose or enable each and every element of the independent claim 1, Broadwin does not disclose or enable each and every element of the dependent claims of the present application. As such, claims 2-4, 6-8, and 10 are also patentable and should be allowed.

### **Claim Rejections – 35 U.S.C. § 103 Over Broadwin and Wistendahl**

Claims 5, 9, 11-14, 19, 23, 25-28, 33, 37, and 39-42 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Broadwin in view of Wistendahl, *et al.* (U.S. Publication No. 2002/0056136) (hereafter, ‘Wistendahl’). As discussed above, claims 19, 23, 25-28, 33, 37, and 39-42 are presently cancelled in this Response. The question of whether Applicants’ remaining claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a *prima facie* case of obviousness to reject Applicants’ claims for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a *prima facie* case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 5, 9, and 11-14. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claims 5, 9, and 11-14 depend from independent claim 1 and include all the limitations of independent claim 1. In rejecting dependent claims 5, 9, and 11-14, the Office Action relies on Broadwin as disclosing each and every element of independent claim 1. As shown above, Broadwin does not disclose each and every element of independent claim 1. Because Broadwin does not disclose each and every element of independent claim 1, the combination of Broadwin and Wistendahl cannot possibly

disclose each and every element of dependent claim 5, 9, and 11-14. The proposed combination of Broadwin and Wistendahl, therefore, cannot establish a prima facie case of obviousness, and the rejections 35 U.S.C. § 103(a) should be withdrawn.

### **Conclusion**

Claim 10 stands rejected under 35 U.S.C. § 112, second paragraph, as failing to point out and distinctly claim the subject matter which the applicant regards as his invention. As shown above, presently amended claim 10 complies with the requirements of 35 U.S.C. § 112, second paragraph. Claim 10 is therefore patentable and should be allowed. Applicants respectfully request reconsideration of claim 10.

Claims 1-4, 6-8, and 10 stand rejected under 35 U.S.C. § 102 as being anticipated by Broadwin. Broadwin does not disclose or enable each and every element of Applicants' claims. Broadwin therefore does not anticipate Applicants' claims. Claims 1-4, 6-8, and 10 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-4, 6-8, and 10.

Claims 5, 9, and 11-14 stand rejected under 35 U.S.C. § 103 as obvious over a combination of Broadwin and Wistendahl. The combination of Broadwin and Wistendahl does not teach or suggest each and every element of Applicants' claims. Claims 5, 9, and 11-14 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 5, 9, and 11-14.

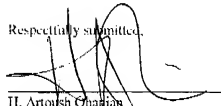


The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447  
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Respectfully submitted,

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By: \_\_\_\_\_

  
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